



Kevin M. Kercher
Blackwell, Sanders, Peper & Martin, LLP
720 Olive Street, 24th Floor
St. Louis, Missouri 63101

In re Application of	:	
BURNS	:	DECISION ON RENEWED
Application No.: 10/006,017	:	
Filing Date: 04 December 2001	:	PETITION UNDER
Atty. Docket No.: 717901.19	:	
For: PLAYING SURFACE SUBSTRATE, IN	:	UNDER 37 CFR 1.182
PARTICULAR TURF MATS	:	

This is a decision on applicant's "Renewed Petition 37 C.F.R. Section 1.182" filed on 30 October 2002 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 30 August 2002, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.182 to convert the present filing under 35 U.S.C. 111(a) to a national stage filing under 35 U.S.C. 371. Applicant was afforded two months to file any request for reconsideration.

On 30 October 2002, applicant filed the present renewed petition.

DISCUSSION

As detailed in the decision mailed 30 August 2002, any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). (See 37 CFR 1.495(g)). It is undisputed that the 04 December 2001 submission did not clearly and unambiguously identify the submission as a national stage application. Therefore, pursuant to 37 CFR 1.495(g) treatment of the submission as a filing under 35 U.S.C. 111(a) was proper.

Applicant argues that certain facts, e.g. the submission of only a preliminary amendment and mailing the submission to "Box PCT" justifies treatment of the submission as a filing under 35 U.S.C. 371. This argument is unpersuasive as such treatment would violate 37 CFR 1.495(g) which mandates that, in the presence of conflicting instructions, the submission will be treated as a filing under 111(a). To grant the relief requested by petitioner would require a waiver of this rule. However, noncompliance with a rule due to a lack of knowledge of the rule is generally not considered an "extraordinary situation" justifying waiver under 37 CFR 1.183. (See MPEP cases cited in Section 513 at 500-61.

As to applicant's contention that there are only three forms listed on the USPTO website related to the Patent Cooperation Treaty, a close look at applicant's "Exhibit B" shows a button entitled "Access to more Patent Cooperation Treaty (PCT) forms on PCT site." This section of the USPTO website contains all necessary forms, most relevantly, the "Form PTO-1390 Transmittal Letter to the US Designated/Elected Office."

Regarding applicant's contention that revival of the present international application will result in "double patenting" of the invention. This is incorrect. Applicant is not barred from having two applications, only two patents.

Applicant also questions in the renewed petition, "[s]hould the Applicant, because of his status as a foreign citizen, suffer an undue hardship and prejudice due to the loss of PCT National Phase status?" Applicant is not being subjected to hardship and prejudice due to his status as a foreign citizen. Rather, any alleged hardship encountered by applicant is attributed to applicant's failure to comply with the mandate under 37 CFR 1.495(g) that the submission be clearly identified as a national stage submission. Further, as indicated in the previous decision, national phase status may be restored pursuant to 37 CFR 1.137(b), or benefit under 35 U.S.C. 120, 365(c) and 119(a)-(b) to the prior PCT and GB applications may be possible under 37 CFR 1.55 and 37 CFR 1.78.

U.S. statutes and regulations do not make specific provision for the requested action and as such, the Office does not grant such petitions for conversion as a mere matter of course. The Office will only grant such petitions upon a showing by applicant of sufficient cause (i.e., the loss of patent rights) where no other remedy is available. As explained in the decision mailed 30 August 2002 and above, other remedies exist in the present case.

CONCLUSION

The renewed petition to convert the application from a 35 U.S.C. 111 filing to a national stage application under 35 U.S.C. 371 is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Boris Milef
PCT Legal Examiner
PCT Legal Office



Derek Putonen
Attorney Advisor
PCT Legal Office
Tel. (703) 305-0130
Fax (703) 308-6459